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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/101,846 07/17/98 FINZEL

L P-981197

EXAMINER

MM22/0223

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HENRY, J

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

02/23/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/101,846

Applicant(s)

Lothar Finzel et al

Examiner

Jon W. Henry

Group Art Unit

2872



☒ Responsive to communication(s) filed on Jan 3, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-47, 49, 50, 52, 53, and 56-72 is/are pending in the application.

Of the above, claim(s) 2-47, 49, 50, 52, 53, and 56-71 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 72 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Jul 17, 1998 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicants' election with traverse of Group I and species (a) in Paper No. 13 is acknowledged. The traversal is on the ground(s) that lack of unity was not found in the PCT prosecution and therefore the examiner cannot hold lack of unity in the national phase. This is not found persuasive because a holding of lack of unity in the PCT prosecution is not controlling with regard to a holding of lack of unity at the national phase. Additionally, it is noted the claims have been amended in a manner raising additional questions concerning lack of unity in accordance with MPEP 1850, A, paragraphs 3 and 4.

Applicants elected one of three species, species (a) which may be termed Bsp1 for purposes of discussion, with nonelected species Bsp2 and Bsp3, all in independent claims. Additionally, applicant included various claims dependent from those independent claims and adding additional features that may variously be termed A, C, D, etc., primarily dependent from Bsp1, and thereby defining combinations Absp1, ACsp1, ADsp1, etc. and all therefore of the type ABsp1. Those claims were determined to have unity of invention with the independent claims based on sharing the special technical features of Bsp, in a manner analogous to MPEP 806.06 (c)

Example ^I II.

However, applicants amended claim 1 to make claim 1 generic to all three species, as stated in their remarks, thereby defining an invention that may be termed Bbr. Consequently, all

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the claims dependent from 1 are drawn to inventions of the type ABbr except for claim 72 that is drawn to Bsp. Applicant seeks examination of all the article claims based on those inventions sharing the special technical features of Bbr. However, amended claim 1 to Bbr has not been found allowable. Such raises new issues of lack of unity of invention as set out in MPEP 1850, A, paragraphs 3 and 4. Specifically, applicant originally included, with regard to elected species Bsp1, claims to Bsp (claim 1) and variously ABsp (claims dependent from claim 1). Now applicant has amended the claims so that only claim 72 is directed to Bsp and all the claims dependent from claim 1 (now drawn to Bbr) are drawn to ABbr. That situation is analogous to MPEP 806.05(c) Example III wherein restriction is deemed proper between ABbr and Bsp or MPEP 806.05(c) example I in view of the application no longer including any claims of the type ABSP. Thus elected invention Bsp and inventions of the type ABbr are not considered to have unity of invention because Bbr has not been found allowable and therefore the allowability of Bsp and ABBR, if any, appears to relate to their separate features rather than the features they share.

Additionally, the serious burden of search and examination of a multiplicity of inventions combining Bbr with various separate features A, C, D, etc., in addition to the search and examination of Bbr and Bsp, in view of the claim to Bbr not being allowable, is evident.

Accordingly, only claims 1 and 72 are now directed to the elected invention and all other claims are withdrawn from consideration by the examiner as directed to nonelected inventions.

Currently, only claim 1 is generic to the species previously restricted See MPEP 806.04(d).

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Additionally, claim 1 link(s) the inventions Bbr variously in combination with features, A, C, D, etc. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "which are designed in terms of pipe connecting technology" is unclear because the metes and bounds of the claims are so uncertain. Additionally, the "lead-in spigots in the form of pipes" are not connected or coordinated with any other elements of the claim. Claim 72 shares only the latter problem with claim 1, but such would be corrected by reciting, for example, "a pipe of the cable lead-in unit".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 72, as far as definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' own admitted prior art in view of Finzel (GB 2277812 A).

Claim 1 is written in Jepson format, presumably in accordance with 37 CFR 1.75(e):

Where the nature of the case admits, as in the case of an improvement, any independent claims should contain in the following order: (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) A phrase

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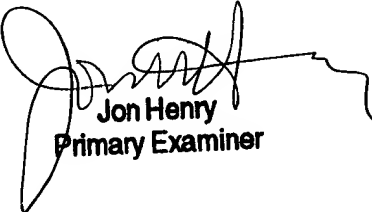
such as "wherein the improvement comprises," and (3) Those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

Although the conventional aspects of the prior art as presumably set out in the preamble of claim 1 may take many forms, it appears reasonable, based on such a presumption, for purposes of visualization the general arrangement of applicants' Fig. 6 may be considered solely with regard to structures of the preamble of claim 1. However, it would have been obvious to one of ordinary skill in the art to use cable lead-in units with lead-in spigots in the form of pipes 5 tightly fitted on the closure body because Finzel discloses such with regard to cable inlet nozzles 5. The one-piece construction of pipes 5 with the closure as shown by Finzel is deemed to be a construction "tightly fitted on the closure body", in fact, about as tightly as possible. Alternatively, if somehow the construction were somehow deemed not tightly fitted, it would have been obvious to one of ordinary skill in the art to make the pipes 5 separately because such is conventional in devices including projecting pipe or tube sections and would avoid problems of one-piece construction. Additionally, that finding of obviousness is in close accord with case law regarding the obviousness of "making separable". In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). One would expect such a pipe to be tightly fitted to seal properly. Also, it would have been obvious to connect a pipe holding fiber cables loosely to such a pipe because Finzel teaches such loose holding of cable 7 and pipe 25 within pipe section 5, the term "loosely" be applicable whether or not an optional bushing seal 26 is provided. Although Finzel does not

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disclose how pipe 25 is secured to pipe section 5, adhesive bonding would have been obvious as a conventional securing means that would assure the desired relationship at all times during shipping and use regardless of tolerances of manufacture.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon W. Henry whose telephone number is (703) 305-6106.



Jon Henry
Primary Examiner

jwh

February 3, 2000